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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 11271STUS01U					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 13, 2006</u> Signature _____ Typed or printed name _____	Application Number <div style="border: 1px solid black; padding: 2px; text-align: center;">09/742,047</div>		Filed <div style="border: 1px solid black; padding: 2px; text-align: center;">December 20, 2000</div>				
	First Named Inventor <div style="border: 1px solid black; padding: 2px; text-align: center;">Steve Okun</div>						
	Art Unit <div style="border: 1px solid black; padding: 2px; text-align: center;">2617</div>	Examiner <div style="border: 1px solid black; padding: 2px; text-align: center;">Brandon J. Miller</div>					
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,620</u> </td> <td style="width: 50%; vertical-align: top; text-align: center;"> <div style="border-top: 1px solid black; margin-bottom: 5px;">/Kevin L. Smith/</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Signature</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Kevin L. Smith, Reg. No. 38620</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Typed or printed name</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">972-772-8836</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Telephone number</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">November 13, 2006</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Date</div> </td> </tr> <tr> <td style="vertical-align: top;"> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td></td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <div style="border: 1px solid black; padding: 5px; margin-top: 10px;"> <input type="checkbox"/> *Total of _____ forms are submitted. </div>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,620</u>	<div style="border-top: 1px solid black; margin-bottom: 5px;">/Kevin L. Smith/</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Signature</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Kevin L. Smith, Reg. No. 38620</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Typed or printed name</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">972-772-8836</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Telephone number</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">November 13, 2006</div> <div style="border-top: 1px solid black; margin-bottom: 5px;">Date</div>	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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DOCKET NO. 11271STUS01U

Customer No. 49,403

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Okun et al.

Serial No. 09/742,047

Filed: December 20, 2000

For: Method & Apparatus in a Network for Advising
and Placing a Calling Party on Hold/Delay

Group No.: 2617

Examiner: Brandon J. Miller

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**ARGUMENT ACCOMPANYING THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Submitted with the Pre-Appeal Brief Request for Review are these arguments and remarks, which are being filed with the filing of a notice of appeal, accompanied by the appropriate fee, and before the filing of an appeal brief. Also attached is a petition for extension of time to extend the period for response to now November 13, 2006.

A final office action had been mailed July 11, 2006, advising, in sum, that Claims 25-32 in the patent application 09/742,047 stand rejected as being unpatentable under 35 USC § 103(a). The rejections stem generally from the hypothetical combination of Cannon, Crockett, Chow, and Forlenza. (see Final Office Action mailed July 11, 2006 [*hereinafter* Final Office Action], namely that:

- Claims 25 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,393,272 to Cannon (“Cannon”) in view of U.S. Patent No. 6,633,634 to Crockett (“Crockett”) and U.S. Patent No. 6,665,375 to Forlenza (“Forlenza”).
- Claims 28-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Crockett.

- Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,606,505 to Chow (“Chow”) in view of Forlenza.
- Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Crockett, Forlenza, and Chow.

Applicant respectfully submits that a *prima facie* basis for obviousness had not been established under the hypothetical combination of the cited references. Reconsideration of the Claims is respectfully requested.

1. Background

Applicant’s invention relates to a “enables a called party to depress a specified digit or otherwise activate a solution to 5 prompt the system to generate a voice message or text message to the calling party to advise the calling party that the called party will be picking up the call shortly. Thus, *the called party is able to rapidly respond* in a way that minimizes how much others are disturbed yet in a manner so as not to risk losing the incoming caller for failure to answer.” (Specification at p. 7, *ll.* 3-10). When placed on hold, the calling party has the capability to remind the called party that the call is on hold.

Applicant’s Independent Claim 25 recites, *inter alia*, a “*mobile station of a calling party*, comprising: communication circuitry for processing wireless communication signals; audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; logic to prompt the mobile station to generate signaling to a communication network element to complete call setup including completing connection of a voice channel and *further to mute the microphone even though the voice channel is connected; logic to prompt the mobile station to prompt a called party to take the call after a specified period of time as a reminder that a calling party is on hold . . .*” (emphasis added).

Also, Applicant’s Independent Claim 28 recites, *inter alia*, a “*mobile station of a calling party*, comprising: communication circuitry for processing wireless communication signals; audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; *logic to prompt the mobile station to prompt a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold*; and logic circuitry for prompting the mobile station to complete call connection including the voice channel and further to mute the microphone until the called party takes the call to prevent audio transmission over the voice channel until the called party takes the call and to transmit a message to the calling party to advise the calling party that the called party will be taking the call shortly.” (emphasis added).

Applicant's Independent Claim 32 recites, *inter alia*, a "method for connecting a call placed by a calling party to a called party having a multi-line capable phone, comprising: . . . *receiving an indication from the called party* to place the calling party on hold; responding to a called party indication by triggering an IVR to play a select message to the calling party to advise the calling party that the called party will be taking the call shortly; and when a specified period of time has elapsed, providing, *on behalf of the calling party*, a reminder to the called party that the second call first call is still on hold." (emphasis added).

2. *Prima Facie* case under 35 U.S.C. § 103(a) lacks some suggestion or motivation to modify the reference or to combine reference teachings

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142, p. 2100-134 (Rev. 3, May 2005) (citations omitted).

a. *Motivation or suggestion for hypothetical combinations improperly derived from Applicant's Specification.*

Applicant respectfully submits that the motivation or suggestion in the cited references stems from Applicant's own specification. The Federal Circuit has noted that "an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996)). "To prevent the use of hindsight based on the invention to defeat patentability of the invention, [the Federal Circuit] requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffett* at 1357.

b. Cannon lacks prompt from the calling party to the called party of the “call on hold”

Cannon recites a telephone 105, as a called party, with a “controller 109 [that] will respond to a signal from Answer & Hold input element 121 of input unit 107 to answer an incoming call, cause the outgoing message unit 119 to output a particular outgoing message, and maintain a connection status of the incoming call.” (Cannon 2:22-27; Figure 1). Cannon does not specifically mention prompting a called party to take the call after a specified period of time. The Final Office Action notes the absence of this element of Cannon. (Final Office Action at p. 2-3).

c. Crockett is a Caller ID telephone that similarly lacks reminder from the calling party to the called party of the “call on hold”

Crockett relates to caller ID systems – Crockett does not cause a called party to place a calling party on hold, and accordingly, cannot have the calling party remind the called party that the call is on hold. Crockett recites a caller-while-waiting ID “system 10 [that] enables a customer at the called communication station 30, *who is busy on a previous call*, to be efficiently and effectively notified that a current call from calling communication station 40 is waiting. The system 10 provides an enhanced call waiting message that includes both the call waiting indicator and the audible representation of information associated with the calling communication station 40.” (Crockett 2:51-58). The called party is provided “with information that assists the [called party] in deciding whether to take the current call.” (Crockett 2:65-67). That is, Crockett is a call waiting system, which “generally notif[ies] a [called party] that is busy on a previous call that a current call has been placed to the customer,” (Crockett 1:14-17), but does not answer the call from the mobile station of a calling party. The calling party has no input to, nor feedback from, the called party.

d. Forlenza is simply a call status display device

Forlenza recites the capability of the calling party to place a calling party on hold; however, Forlenza does not recite any further action by the called party terminal. (*see, e.g.*, Forlenza Col. 4:64-67). Forlenza recites a “telephone with a *customized display for displaying call connection status information* . . . such as ringing and busy signals, and presents the call status via a status indicator.” (Forlenza 1:42-47). The status information is depicted in Figure 2A. In sum, Forlenza is a display status device cited because it contains an IVR capability, generally.

e. Chow recites a call hold, but no calling party reminder prompt to the called party

Chow recites a “wireless centrix system (WCS) that allows a subscriber to use the same standard cellular/PCS telephone in both the wireless centrix system domain as well as the public cellular system

domain. In the WCS domain, subscribers can use their cellular PCS as a cordless-like phone without incurring air-time charges. The WCS "provides a user with the ability to interactively place an incoming call on hold in real time without first answering the call,-have the caller automatically instructed that the call is on hold, and to pickup the call sometime in the near future." (Chow Col. 4:4-8).

3. Conclusion

Applicant respectfully submits that the cited references do not provide every element of Applicant's claimed invention, and further that "prior art corollaries" from the cited references are improperly relied upon in the rejection, and that a *prima facie* case of obviousness had not been established. Further, the hypothetical combination of the cited references does not teach or suggest all the claim limitations.

Accordingly, Applicant respectfully submits that Claims 25 - 32 are in condition for allowance, and that the rejections be withdrawn stated herein.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (11271STUS01U).

Respectfully submitted,

Date: November 13, 2006

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